

Docket No.: 22114-00001-US1  
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Patent Application of:  
Jerome Asius et al.

Application No.: 10/809,349 (Patent No. 7,731,758)

Confirmation No.: 7560

Filed: March 26, 2004

Art Unit: 3774

For: IMPLANT FOR SUBCUTANEOUS OR  
.....  
INTRADERMAL INJECTION

Examiner: Prebilic, Paul B.

**REQUEST FOR RECONSIDERATION OF PATENT TERM**  
**ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)-(d)**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Responsive to the Determination of Patent Term Adjustment posted on the Patent Application Information Retrieval System (PAIR) on June 8, 2010, the issue date of U.S. Patent No. 7,731,758, and in light of the recent *Wyeth v. Kappos*, 591 F.3d 1364 (Fed. Cir. 2010), the Patentees submit this Request for Reconsideration of Patent Term Adjustment under 37 C.F.R. § 1.705(b)-(d). This request is being submitted within two months of the issue date (i.e., of June 8, 2010) of U.S. Patent No. 7,731,758, and complies with the deadline specified in 37 C.F.R. §1.705(d). Thus, Patentees contend this request is timely.

The data available on PAIR indicates that U.S. Patent No. 7,731,758 has been granted 1651 days of Patent Term Adjustment. *See* Exhibit A. Patentees submit that, due to the recent *Wyeth* decision, the correct Patent Term Adjustment should be 1747 days. Patentees therefore request that U.S. Patent No. 7,731,758 be granted an additional 96 days of patent term.

Statement of the Facts and Explanation of the Calculation Under § 1.703(a)-(f):

For purposes of this request, and in keeping with the explanation provided in *Wyeth*, Patentees will refer to the delays under 35 U.S.C. § 154(b)(1)(A) as “‘A’ delays,” the delays under 35 U.S.C. § 154(b)(1)(B) as “‘B’ delays,” and the delays under § 154(b)(1)(C) as “‘C’ delays.” The 7,731,758 patent is not subject to a terminal disclaimer. Under the “A” delays, the Patent Office delayed prosecution by 654 days by:

- (i) mailing a Non-Final Office Action on March 8, 2007 which was 651 days after May 26, 2005 (i.e., the date that is 14 months from March 26, 2004 (the actual filing date of the Patentees’ application)); and
- (ii) mailing a Notice of Allowance on January 26, 2010 which was 3 days after January 23, 2010 (i.e., the date that is 4 months after the Board of Patent Appeals and Interferences’ (BPAI) decision (dated September 23, 2009) reversing the Examiner’s rejections). See Exhibit B.

0 days of the delay in issuing the Non-Final Office Action overlap with the “B” delay (see below) because all of the days of delay occurred prior to March 26, 2007 (the date that is 3 years from March 26, 2004 (the actual filing date of the Patentees’ application)). See Exhibit B. 3 of the days of delay in issuing the Notice of Allowance overlap with the “B” delay because all of those days of delay occurred after March 26, 2007. Therefore, in accordance with *Wyeth*, the total “A” delays by the Patent Office is 651 days (issuance of first communication more than 14 months from filing delay) + 3 days (issuance of Notice of Allowance more than 4 months after the BPAI’s decision reversing the Examiner delay) – 3 days (“A” delays overlapping with the “B” delay) = 651 days.

The Patent Office also delayed issuance of the patent by more than three years. Specifically, the “B” delay period commenced on March 26, 2007 (i.e., the date that is 3 years after March 26, 2004 (the actual filing date of the Patentees’ application)). In this case, the patent was issued on June 8, 2010 which was 1170 days after March 26, 2007. See Exhibits A and B. 634 of these days were consumed by appellate review by the BPAI (i.e., 634 days elapsed from the date the Notice of Appeal was filed December 28, 2007 to the date the BPAI issued its decision reversing the Examiner’s rejections on September 23, 2009). See Exhibit B. Furthermore, 37 of these days were consumed by Applicant’s delays. Specifically, Applicant

responded to a Non-Final Office Action 7 days after three months had elapsed from the mailing of the Non-Final Office Action (i.e., the Non-Final Office Action was mailed on March 8, 2007 but Applicant did not respond until June 15, 2007). *See* Exhibit B. Applicant also delayed in responding to the Final Office Action by 30 days (i.e., the Final Office Action was mailed August 28, 2007 but Applicant did not respond until December 28, 2007 when the Notice of Appeal was filed). *See id.* Therefore, the Patent Office was responsible for 499 total days of “B” delays (i.e., 1170 days (delay in taking more than three years to issue the patent) – 634 days (delays consumed by appellate review) – 37 days (Applicant’s delays) = 499 days).

Patentees are also guaranteed 634 days of adjustments for the “C” delays that occurred during the appellate review by the BPAI. In this case, the patent was issued under a decision in the review reversing an adverse determination of patentability. *See* Exhibit B. Applicants filed the Notice of Appeal in this case on December 28, 2007, and the BPAI issued a decision reversing the Examiner 634 days later, on September 23, 2009. *See id.*

Finally, as noted above, Applicants’ delay under § 1.704 was 37 days. Therefore, the Patent Office is responsible for a total of 1784 days of delay (i.e., 651 days of non-overlapping “A” delays + 499 days of “B” delays + 634 days of “C” delays), while Applicants are responsible for 37 days of delay. Patentees therefore contend that the proper patent term adjustment for U.S. 7,731,758 is **1747 days**.

In view of the above, Patentees respectfully request that an additional 96 days of Patent Term Adjustment be added to the patent term for Patent Office delay, resulting in a total Patent Term Adjustment of 1747 days.

Patent No.: 7,731,758  
Application No.:10/809,349

Docket No.: 22114-00001-US1

The Commissioner is authorized to charge the \$200.00 fee set forth in § 1.18(e) in accordance with 37 C.F.R. § 1.705(b)(1). The Commissioner is also authorized to charge any additional fees required by this paper or credit any overpayment to Deposit Account No. 22-0185, under Order No. 22114-00001-US1, from which the undersigned is authorized to draw.

Dated: August 6, 2010

Respectfully submitted,

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Attorneys for Applicant

Exhibit A – Patent Term Adjustment History for U.S. 7,731,758  
Exhibit B – Transaction History from PAIR for U.S. 7,731,758

## EXHIBIT A



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### 10/809,349 IMPLANT FOR SUBCUTANEOUS OR INTRADERMAL INJECTION

Select New Case	Application Data	Transaction History	Image File Wrapper	Patent Term Adjustments	Continuity Data	Foreign Priority	Fees	Published Documents	Address & Attorney/Agent
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#### Patent Term Adjustment

Filing or 371(c) Date:	03-26-2004	USPTO Delay (PTO) Delay (days):	-
Issue Date of Patent:	06-08-2010	Three Years:	-
Pre-Issue Petitions (days):	-	Applicant Delay (APPL) Delay (days):	-
Post-Issue Petitions (days):	-	Total Patent Term Adjustment (days):	1651
USPTO Adjustment (days):	-	Explanation Of Calculations:	

#### Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
06-08-2010	PTA 36 Months	401	
06-08-2010	Patent Issue Date Used in PTA Calculation		
04-27-2010	Dispatch to FDC		
04-26-2010	Application Is Considered Ready for Issue		
04-22-2010	Issue Fee Payment Verified		
04-22-2010	Issue Fee Payment Received		
01-26-2010	Mail Notice of Allowance		
01-24-2010	Notice of Allowance Data Verification Completed		
01-24-2010	Examiner's Amendment Communication		
01-22-2010	Document Verification		
10-07-2009	Mail BOA miscellaneous communication to applicant		
10-07-2009	BOA miscellaneous communication to applicant		
09-23-2009	Mail BPAI Decision on Appeal - Reversed	636	

09-23-2009	BPAI Decision - Examiner Reversed	⌘
08-17-2009	Confirmation of Hearing by Appellant	⌘
07-27-2009	Notification of Appeal Hearing	⌘
01-20-2009	Docketing Notice Mailed to Appellant	⌘
01-17-2009	Assignment of Appeal Number	⌘
12-02-2008	Appeal Awaiting BPAI Docketing	⌘
09-15-2008	Correspondence Address Change	⌘
08-21-2008	Mail Reply Brief Noted by Examiner	⌘
08-19-2008	Reply Brief Noted by Examiner	⌘
07-24-2008	Date Forwarded to Examiner	⌘
07-09-2008	Reply Brief Filed	⌘
07-09-2008	Request for Oral Hearing	⌘
05-09-2008	Exam. Ans. Review Complete	⌘
05-08-2008	Examiner's Answer to Appeal Brief	⌘
03-06-2008	Appeal Brief Review Complete	⌘
03-06-2008	Date Forwarded to Examiner	⌘
02-27-2008	Appeal Brief Filed	⌘
12-28-2007	Notice of Appeal Filed	30
12-18-2007	Mail Advisory Action (PTOL - 303)	⌘
12-17-2007	Advisory Action (PTOL-303)	⌘
12-13-2007	Date Forwarded to Examiner	⌘
12-07-2007	Amendment after Final Rejection	⌘
12-07-2007	Request for Extension of Time - Granted	⌘
11-27-2007	Examiner Interview Summary Record (PTOL - 413)	⌘
10-12-2007	Case Docketed to Examiner in GAU	⌘
08-28-2007	Mail Final Rejection (PTOL - 326)	⌘
08-27-2007	Final Rejection	
06-15-2007	Information Disclosure Statement considered	
06-15-2007	Information Disclosure Statement considered	
06-19-2007	Date Forwarded to Examiner	
06-15-2007	Response after Non-Final Action	7

06-15-2007	Request for Extension of Time - Granted	651
06-15-2007	Reference capture on IDS	
06-15-2007	Electronic Information Disclosure Statement	
06-15-2007	Information Disclosure Statement (IDS) Filed	
06-15-2007	Information Disclosure Statement (IDS) Filed	
03-08-2007	Mail Non-Final Rejection	
03-02-2007	Non-Final Rejection	
06-25-2004	Information Disclosure Statement: considered	
11-29-2004	Information Disclosure Statement: considered	
03-24-2005	Information Disclosure Statement: considered	
04-29-2005	Information Disclosure Statement: considered	
10-18-2006	Case Docketed to Examiner in GAU	
09-26-2004	Preliminary Amendment	
09-27-2005	Miscellaneous Incoming Letter	
04-29-2005	Reference capture on IDS	
04-29-2005	Information Disclosure Statement (IDS) Filed	
04-29-2005	Information Disclosure Statement (IDS) Filed	
03-24-2005	Reference capture on IDS	
03-24-2005	Information Disclosure Statement (IDS) Filed	
03-24-2005	Information Disclosure Statement (IDS) Filed	
11-29-2004	Reference capture on IDS	
11-29-2004	Information Disclosure Statement (IDS) Filed	
11-29-2004	Information Disclosure Statement (IDS) Filed	
07-30-2004	IFW TSS Processing by Tech Center Complete	
06-25-2004	Reference capture on IDS	
06-25-2004	Information Disclosure Statement (IDS) Filed	
06-25-2004	Information Disclosure Statement (IDS) Filed	
06-21-2004	Application Return from OIPE	
06-21-2004	Application Return TO OIPE	
06-21-2004	Application Dispatched from OIPE	
06-21-2004	Application Is Now Complete	



05-13-2004	Cleared by OIPE CSR	⌘
04-24-2004	IFW Scan & PACR Auto Security Review	⌘
03-26-2004	Initial Exam Team nn	⌘

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## Available Documents

Mail Room	Date	Document Code	Document Description	Page
	05-19-2010	ISSUE.NTF	Issue Notification	
	04-22-2010	IFEE	Issue Fee Payment (PTO-958)	
	04-22-2010	WFEE	Fee Worksheet (PTO-875)	
	04-22-2010	N417	EFS Acknowledgment Receipt	
	01-26-2010	NOA	Notice of Allowance and Fees Due (PTOL-85)	
	01-26-2010	NOA	Notice of Allowance and Fees Due (PTOL-85)	
	01-26-2010	IIFW	Issue Information including classification, examiner, name, claim, renumbering, etc.	
	01-26-2010	BIB	Bibliographic Data Sheet	
	01-26-2010	SRNT	Examiner's search strategy and results	
	10-07-2009	CTMS	Miscellaneous Action with SSP	
	09-23-2009	APDR	BPAI Decision - Examiner Reversed	
	08-14-2009	APCH	Confirmation of Hearing by Appellant	
	07-27-2009	APNH	Notification of Appeal Hearing	
	01-20-2009	AP_DK_M	Appeal Docketing Notice	
	09-16-2008	EBCC.AD	Notice of Change of Address placed in File Wrapper due to EBC Customer Number update	
	08-21-2008	RBNE	Reply Brief Noted - BPAI	
	07-09-2008	APOH	Request for Oral Hearing	
	07-09-2008	APRB	Reply Brief Filed	
	07-09-2008	WFEE	Fee Worksheet (PTO-875)	
	07-09-2008	N417	EFS Acknowledgment Receipt	
	05-09-2008	APEA	Examiner's Answer to Appeal Brief	

02-27-2008	APAF	Affidavit/Dec/Exhibit after Notice of Appeal
02-27-2008	APAF	Affidavit/Dec/Exhibit after Notice of Appeal
02-27-2008	APAF	Affidavit/Dec/Exhibit after Notice of Appeal
02-27-2008	APAF	Affidavit/Dec/Exhibit after Notice of Appeal
02-27-2008	WFEE	Fee Worksheet (PTO-875)
02-27-2008	N417	EFS Acknowledgment Receipt
02-27-2008	AP.B	Appeal Brief Filed
12-28-2007	N/AP	Notice of Appeal Filed
12-28-2007	WFEE	Fee Worksheet (PTO-875)
12-28-2007	N417	EFS Acknowledgment Receipt
12-18-2007	CTAV	Advisory Action (PTOL-303)
12-18-2007	ANE.I	Amendment After Final or under 37CFR 1.312, Initiated by the examiner.
12-07-2007	A.NE	Amendment After Final
12-07-2007	REM	Applicant Arguments/Remarks Made in an Amendment
12-07-2007	WFEE	Fee Worksheet (PTO-875)
12-07-2007	N417	EFS Acknowledgment Receipt
12-07-2007	WFEE	Fee Worksheet (PTO-875)
11-27-2007	EXIN	Examiner Interview Summary Record (PTOL - 413)
08-28-2007	CTFR	Final Rejection
08-28-2007	1449	List of References cited by applicant and considered by examiner
08-28-2007	892	List of references cited by examiner
08-28-2007	SRFW	Search information including classification, databases and other search related notes
08-27-2007	SRNT	Examiner's search strategy and results
06-15-2007	IDS	Information Disclosure Statement (IDS) Filed (SB/QB)
06-15-2007	IDS	Information Disclosure Statement (IDS) Filed (SB/QB)
06-15-2007	FOR	Foreign Reference
06-15-2007	FOR	Foreign Reference
06-15-2007	FOR	Foreign Reference
06-15-2007	FOR	Foreign Reference
06-15-2007	NPL	NPL Documents
06-15-2007	WFEE	Fee Worksheet (PTO-875)
06-15-2007	N417	EFS Acknowledgment Receipt
06-15-2007	XT/	Extension of Time

06-15-2007	A...	Amendment/Req. Reconsideration-After Non-Final Reject
06-15-2007	CLM	Claims
06-15-2007	REM	Applicant Arguments/Remarks Made in an Amendment
06-15-2007	WFEE	Fee Worksheet (PTO-875)
03-08-2007	CTNF	Non-Final Rejection
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03-08-2007	892	List of references cited by examiner
03-08-2007	FOR	Foreign Reference
03-08-2007	FOR	Foreign Reference
03-08-2007	FOR	Foreign Reference
03-08-2007	FOR	Foreign Reference
03-08-2007	FOR	Foreign Reference
03-08-2007	FOR	Foreign Reference
03-08-2007	SRFW	Search information including classification, databases and other search related notes
03-01-2007	SRNT	Examiner's search strategy and results
10-24-2006	WFEE	Fee Worksheet (PTO-875)
09-27-2005	STATUS.LET	Request for status of Application
04-29-2005	IDS	Information Disclosure Statement (IDS) Filed (SB/05)
04-29-2005	FOR	Foreign Reference
04-29-2005	FOR	Foreign Reference
04-29-2005	FOR	Foreign Reference
04-29-2005	FOR	Foreign Reference
03-24-2005	IDS	Information Disclosure Statement (IDS) Filed (SB/05)
11-29-2004	IDS	Information Disclosure Statement (IDS) Filed (SB/05)
06-25-2004	IDS	Information Disclosure Statement (IDS) Filed (SB/05)
03-26-2004	TRNA	Transmittal of New Application
03-26-2004	136A	Authorization for Extension of Time all replies
03-26-2004	SPEC	Specification
03-26-2004	CLM	Claims
03-26-2004	ABST	Abstract
03-26-2004	OATH	Oath or Declaration Filed
03-26-2004	A.PE	Preliminary Amendment
03-26-2004	SPEC	Specification
03-26-2004	CLM	Claims

03-26-2004	REM	Applicant Arguments/Remarks Made in an Amendment
03-26-2004	ADS	Application Data Sheet
03-26-2004	WCLM	Claims Worksheet (PTO-2022)
03-26-2004	WFEE	Fee Worksheet (PTO-875)
03-26-2004	WFEE	Fee Worksheet (PTO-875)

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